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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/809,965 | 03/16/2001 | Frank J. Androski | 2000-0344 | 7124 |

7590

03/23/2004

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| EXAMINER |
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HONG, HARRY S

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| ART UNIT | PAPER NUMBER |
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2642

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/809,965

Applicant(s)

ANDROSKI ET AL.

Examiner

Harry S. Hong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4 and 5.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 6-8, and 15-17 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ryan (US 5,237,604; cited and applied for the first time).

Refer to FIG. 1 of Ryan. The claimed first switch reads on the SUBTENDING SWITCH 10 of Ryan. The claimed centralized network routing database reads on the DATABASE 90. The claimed downstream switch reads on the DIGITAL SWITCH 50. And the entire disclosure of Ryan is plainly directed to the claimed steps.

3. Claims 1-4, 6-8, and 11-20 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Galloway et al. (Galloway; US 5,940,492; cited and applied for the first time).

The entire patent to Galloway plainly teaches the claimed methods of routing a call by launching a query in order to identify at least one downstream switch. Galloway further teaches the TCAP protocol along with DPC and establishing LRN.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, 6-8, and 11-20 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Dunn, Jr. et al. (Dunn; US 6,639,981 B1; cited and applied for the first time).

The entire patent to Dunn also plainly teaches the claimed methods of routing a call by launching a query in order to identify at least one downstream switch. Dunn also further teaches the TCAP protocol along with DPC and establishing LRN.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 3, 4, 11-14, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan as applied above in view of Galloway or Dunn.

Ryan fails to teach the TCAP protocol along with DPC and establishing LRN. However, Galloway or Dunn teaches the same basic principle as Ryan but utilizing TCAP protocol along with DPC and establishing LRN. Therefore, it would have been obvious even to one of ordinary skill in the art at the time of the invention to utilize the updated signaling of Galloway or Dunn in the system and method of Ryan. Updated signaling protocols would provide faster and more efficient signaling.

10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan in view of Galloway or Dunn as applied to claims 3, 4, 11-14, and 18-20 above.

To replace the DPC of Ryan in view of Galloway or Dunn with the NSI would have been a matter of pure design choice.

11. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan as applied above in view of Shenoda et al. (Shenoda; US 6,389,130; cited and applied for the first time).

Ryan teaches sending IAM but fails to teach the BICC signaling protocol. However, Shenoda teaches sending IAM using BICC signaling protocol along with the

feature of forward and backward signaling (Refer to column 9, line 23 – column 10, line 65). Therefore, Utilizing the BICC signaling protocol as taught by Shenoda in the system and method of Ryan would have been obvious even to one of ordinary skill in the art at the time of the invention. Updated signaling protocols provide faster and more efficient signaling.

12. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Galloway or Dunn as applied above.

To replace the DPC of Galloway or Dunn with the NSI would have been a matter of pure design choice.

13. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Galloway or Dunn as applied above in view of Shenoda.

Galloway or Dunn teaches sending IAM but fails to teach the BICC signaling protocol. However, Shenoda teaches sending IAM using BICC signaling protocol along with the feature of forward and backward signaling (Refer to column 9, line 23 – column 10, line 65). Therefore, utilizing the BICC signaling protocol as taught by Shenoda in the system and method of Galloway or Dunn would have been obvious even to one of ordinary skill in the art at the time of the invention. Updated signaling protocols provide faster and more efficient signaling.

Oath/Declaration

14. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

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The oath or declaration is defective because:
Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry S. Hong whose telephone number is (703) 306-3040. The examiner can normally be reached on Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad F. Matar can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Harry S. Hong

Harry S. Hong
Primary Examiner
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March 15, 2004